

REMARKS

Claims 1-18 are all the claims pending in the application, with claims 1 and 15 being the only independent claims.

Claims 1-10 and 12-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pecoraro (U.S. patent 5,866,829). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Pecoraro in view of Gillaspy (U.S. patent 5,506,371). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Rejection under 35 U.S.C. §103(a) as being anticipated by Pecoraro

The Examiner rejects claims 1-10 and 12-18 under 35 U.S.C. §103(a) as being unpatentable over by Pecoraro.

Applicant acknowledges the Examiner's indication on page 5 of the Office Action that the arguments submitted in the previous response have been considered and are persuasive. Application also notes with appreciation the Examiner's analysis on this matter, but nevertheless disagrees with the position set forth in the Action. The various points made in the Action will now be addressed.

Prima facie case of obviousness has not been met

To establish a *prima facie* case of obviousness, the Examiner bears the burden of demonstrating that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings; (2) there is a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicant submits that the identified third element necessary for establishing a *prima facie* case of obviousness (i.e., that the prior art reference must teach or suggest all the claim limitations), has not been met. Page 2 of the Action indicated that Pecoraro does not disclose the claimed “readily positionable” aspect of the individual foot controller modules. No other reference was cited as providing this feature, thus the third element of a *prima facie* case of obviousness has not been met.

Applicant recognizes that the Action sets forth comments that the claimed “readily positionable” aspect relates to mere “adjustability,” and that simply claiming “adjustability” is not a patentable advance, thus supporting a rejection under 35 U.S.C. § 103(a). The action relies upon *In re Stevens*, 212 F.2d 197, 101 USPQ 284 (CCPA 1954) for support of this position.

Applicant is well aware of the cited case, and its applicability to obviousness rejections under § 103(a). However, *In re Stevens* does not supersede the requirements MPEP § 2143; namely, the third element specifying that the prior art reference must teach or suggest all the claim limitations. Indeed, the rejection addressed in *In re Stevens* relied upon three separate references as teaching all the claim limitations of the claim at issue. The Court in *In re Stevens* did not hold that an obviousness rejection can be made using a reference which does not teach or suggest all the claim limitations.

Applicant acknowledges that the holding of *In re Stevens* provides the basis for a proper rejection under § 103(a). However, that is not the case in the present action since the cited

Pecoraro patent does not teach or suggest all the claim limitations. For these additional reasons, a *prima facie* case of obviousness has not been met.

Official Notice

Since the present Action fails to identify any reference which provides the requisite teaching of all elements of claim 1, Applicant surmises that the Examiner could possibly be taking official notice of the claimed "readily positionable" aspect. If this is indeed the case, Applicant acknowledges that in limited circumstances it is appropriate for an Examiner to take such official notice of facts not in the record, or to rely on "common knowledge" in making a rejection. However, MPEP § 2144.03 requires that "such rejections should be judiciously applied."

Furthermore, "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." (MPEP § 2144.3[A], 2100-136 (May 2004)). This section of the MPEP further provides that "the notice of facts beyond the record which may be taken by the examiner must be capable of such instant and unquestionable demonstration as to defy dispute" (internal citations omitted).

Claim 1 includes limitations which are not "common knowledge" or "well-known" in the art. Specifically, it is not common knowledge or well-known for a customizable aggregated floor controller to include "a mounting frame securing said plurality of individual foot controller modules in a reconfigurable mounting arrangement" or that "each foot controller module . . . is readily positionable within any of a plurality of mounting locations of said mounting frame." Applicant has reviewed a number of prior art references, including those cited in the IDS and the

various patents referred in the present Office Action. None of these references teach or suggest, *inter alia*, these claim features.

In view of the foregoing, Applicant respectfully requests that the Examiner provide the required documentary evidence in the next office action if the rejection to the identified claims is to be maintained. (MPEP § 2144.3[C], 2100-138 (May 2004); see also 37 CFR § 1.104(c)(2)). In addition, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner is further requested to provide an affidavit or declaration setting forth specific factual statements and explanation to support the findings recited in the Office Action. See 37 CFR § 1.104(d)(2).

Signal Interface

Applicant next address the claimed “signal interface” element. Applicant has carefully reviewed the Examiner’s comments to Applicant’s last response in this matter which are set out on page 5 of the present Office Action. However, Applicant is unable to locate the Examiner’s comments on this point. It is quite possible that the Examiner has inadvertently overlooked Applicant’s comments on this point. Accordingly, for the convenience of the Examiner, Applicant’s previously submitted comments with regard to this claim element are reproduced below.

Claim 1 is further distinguishable since it recites “a signal interface adapted to transmit interface signals to an external system.” The claim further requires that “said interface signals are generated in response to one or more of said electrical signals generated by said plurality of individual foot controller modules.” Page 2 of the Action indicated that sound control unit 16 of Pecoraro teaches the just-identified claim limitation. Applicant respectfully disagrees.

Applicant has thoroughly reviewed the Pecoraro patent and is unable to locate any such teaching relating to the just-identified claim features. Pecoraro simply states that the sound control unit 16 receives signals from electronic components 14, and then goes on to describe how the sound control unit 16 can be pivotally mounted within case 12. Applicant submits that the Pecoraro sound control unit 16 is simply a rack-mounted conventional modular audio processing device. The sound control unit 16 is thus an audio signal processing device providing an audio signal processing function, and does not teach or suggest the identified "signal interface" feature of claim 1.

For the convenience of the Examiner, reproduced below are various portions of the Pecoraro patent which relate to the sound control unit 16. As Applicant best understands this patent, these portions represent the entire disclosure relating to the sound control unit 16.

"A sound control unit 16 may be electrically connected to the electronic components 14. A facility 18 is for pivotally mounting the sound control unit 16 within the case 12. The sound control unit 16 can go between a generally horizontal storage position "A" over the electronic components 14 and into an upright operational position "B" for easy access. The sound control unit 16 may also be completely removed from the case 12." (Col. 4, lines 8-16).

"The case 12 consists of a base 20 for receiving the electronic components 14 and the pivotally mounting facility 18 with the sound control unit 16. A cover 22 fits over the base 20, when the sound control unit 16 on the pivotally mounting facility 18 is placed into the generally horizontal storage position "A" over electronic components 14. A plurality of latch mechanisms 24 hold the cover 22 onto the base 20, so that the case 12 holding the electronic components 14 and the pivotally mounting facility 18 with the sound control unit 16 can be safely transported." (Col. 4, lines 18-26).

"The sound control unit 16 includes a box shaped housing 30, having a front face panel 32." (Col. 4, lines 30-32).

"A structure 44 is for attaching an upper end of each elongate arm 40 to a front corner of the sound control unit 16." (Col. 4, lines 42-44).

Applicant is unable to locate in the above passages where sound control unit 16 is "adapted to transmit interface signals to an external system," or where "said interface signals are

generated in response to one or more of said electrical signals generated by said plurality of individual foot controller modules.” Pecoraro is silent on these aspects. The above passages clearly demonstrate the shortcomings of the Pecoraro patent as an enabling reference with regard to the above-noted “signal interface” features recited by claim 1.

Adjustability-- *In re Stevens* does not apply

Applicant again acknowledges that *In re Stevens* provides rationale for a rejection under § 103(a). However, such a rejection is only proper if the facts in a prior legal decision, such as the asserted *In re Stevens*, are sufficiently similar to those in the present application. See MPEP § 2144. Applicant will demonstrate that the circumstances in *In re Stevens* are completely different than those of the present application, rendering *In re Stevens* inapplicable.

The claims at issue in *In re Stevens* were directed to a handle for a fishing rod which had two so-called “adjustable” components. First, the handle had a longitudinally adjustable finger hook. Second, the angle of the hand grip was adjustable relative to the fishing rod.

There are several differences between claim 1 and the fishing rod scrutinized by the Court in *In re Stevens*. First, Applicant’s claim 1 does not recite a mounting frame or foot controller modules which are “adjustable.” To the contrary, Applicant’s claim 1 requires a “reconfigurable mounting arrangement.” Applicant’s “reconfigurable” aspect is not the same thing as being “adjustable,” as this term was examined in *In re Stevens*.

Nevertheless, taken alone, Applicant acknowledges that it is possible that one may allege that the term “reconfigurable mounting arrangement” is the same as “adjustable mounting arrangement.” However, claim 1 does not simply recite a “reconfigurable mounting arrangement,” but instead further requires that “each foot controller module . . . is readily

positionable within any of a plurality of mounting locations of said mounting frame.” This is not a mere “adjustment” of the involved structures. That is, there is not just an “adjustment” of either or both of the mounting frame and the individual foot controller modules. To the contrary, the recited structures are such that each foot controller module “is readily positionable within any of a plurality of mounting locations of said mounting frame.”

If the facts of the present application were indeed similar to those in *In re Stevens*, then the following would have had to occur. To be similar, the finger hook or hand grip of *In re Stevens* must be readily positionable within any of a plurality of mounting locations of the handle. For instance the handle must have been structured so that the finger hook could be mounted at any of a plurality of different positions. However, this was not the situation in *In re Stevens*. Again, Applicant’s claim 1 specifically recites “a plurality of mounting locations.” In contrast, the finger hook and hand grip of *In re Stevens* were mounted in one, and only one, location. Simply put, *In re Stevens* relates to “adjustable” components mounted in only one location, whereas claim 1 relates to “a plurality of mounting locations.”

To summarize, *In re Stevens* relates to the adjustable positioning of a finger hook and hand grip relative to the handle. Under a very dissimilar set of facts, Applicant’s claim 1 relates to “a plurality of mounting locations.” The circumstances present *In re Stevens* are completely different than those of the present application, and thus, MPEP § 2144 compels a finding that *In re Stevens* does not apply to the present application.

Plurality of mounting locations

As previously noted, claim 1 requires that “each foot controller module . . . is readily positionable within any of a plurality of mounting locations of said mounting frame.” In the last

response, Applicant set forth reasons why Pecoraro did not teach or suggest this feature. Applicant emphasized that the disclosure of Pecoraro is simply limited to retaining electronic components 14 in only one position within the case.

Page 6 of the present Action provided comments to Applicant's previous response on this point. The Examiner disagreed with Applicant, and stated the following:

“The modules of Pecoraro could be both retained and readily positionable. For example, while using and or transporting the foot controllers, it is important to keep them in a position. But this does not preclude rearranging of the modules.” (Emphasis added).

Applicant notes that the Examiner indicated that the modules of Pecoraro could be both retained and readily positionable. Even if this were true, neither Pecoraro, nor any other reference of record, provides any such teaching or motivation. “The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (Citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original)). The present Office Action does not indicate which prior art reference suggests the modification proposed by the Examiner. It appears that the Examiner has made an obviousness determination with the benefit of hindsight, after having read the disclosure of the present application, which is improper. (See e.g., *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Accordingly, claim 1 is believed to be patentable over Pecoraro for this additional reason.

Foot controller modules

Lastly, Applicant addresses the “foot controller modules” element, which is yet another feature missing from the Pecoraro patent. In particular, claim 1 recites “said plurality of

individual foot controller modules generates an electrical signal in response to user operation of said individual foot controller module.” Applicant previously argued that the cited Pecoraro elements 14 and 26 simply operate using varying aspects of processing applied to incoming input audio signals, but do not themselves “generate electrical signals in response to user operation” as recited by claim 1.

Page 6 of the present Action provided comments to Applicant’s previous response on this point. The Examiner disagreed with Applicant, and stated that Applicant’s previous arguments do not appear to be consistent with the specification. In response, Applicant respectfully submits that the Examiner has not fully appreciated Applicant’s position on this point. First of all, it is not Applicant’s position that the modules of Pecoraro “do not generate an electrical signal.” Applicant even assumes, for the sake of argument, that elements 14 and 26 of Pecoraro do generate electrical signals.

The distinction that Applicant makes relates to how these electrical signals are generated. In Pecoraro, elements 14 and 26 operate responsive to audio signals. In contrast, claim 1 recites that “said plurality of individual foot controller modules generates an electrical signal in response to user operation of said individual foot controller module.” Simply put, Pecoraro relates to “audio signals,” whereas claim 1 utilizes “user operation.”

Applicant further acknowledges page 6 of the present Action which references paras. 274 and 280 of the patent publication of the present application, and paras. 257-267 of U.S. patent publication 2005/0005111. The Action indicated that the various components referred to at these locations “process an audio signal.” Applicant respectfully disagrees.

Paras. 274 and 280 of the patent publication of the present application refer to various modules. These modules generate an electrical signal in response to user operation, not in response to audio signals.

Moreover, in the '111 publication, several examples are given as to how derived parameters may be used to control musical processes and lighting control, effectively allowing one to "fingerpaint" with sound and/or light. It was noted that one possible example of a mapping is to use all six parameters to control prominent features of a single synthesizer voice. The various parameters referenced in the publication relate to various techniques that a user may interact with a pressure-sensor array touch-pad. Signals generated by such touch-pads are therefore generated response to user operation of the touch-pads, not according to an audio signal as alleged in the Action. Applicant is unable to discern how either of these publications contradict Applicant's position set forth herein.

Page 6 of the Action also indicated that "it is reasonable to interpret Pecoraro as generating a fuzz tone, or generating a chorus effect." Applicant does not understand the significance of this statement; none of the claims recite such elements. Clarification is requested if the rejection is maintained on this point.

In view of the foregoing, Pecoraro fails to teach or suggest a number of features recited in claim 1, and therefore this claim is believed to be patentable. Independent claim 15 recites similar language, and is therefore also believed to be patentable for similar reasons. Dependent claims 2-12, and 13-18 are further believed to be patentable at least by virtue of their respective dependencies on the patentable independent claims 1 and 15.

Rejection Under 35 U.S.C. §103(a)
as being unpatentable over Pecoraro and Gillaspy

The Examiner rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over Pecoraro in view of Gillaspy. Applicant has demonstrated above that Pecoraro does not teach or suggest various features recited in claim 1. Applicant further submits that Gillaspy does not supply any of the deficiencies of Pecoraro. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of Pecoraro and Gillaspy in the manner asserted, claim 1 would be patentable at least by virtue of its dependency upon patentable independent claim 1.

CONCLUSION

In light of the above remarks, Applicant submits that the present Response places all claims of the present application in condition for allowance. Reconsideration of the application is requested.

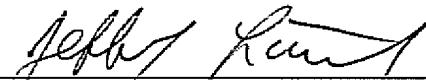
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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